

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Robert E. POLLIN

Appl. No.: 09/492,133

Filed: January 27, 2000

For: **Automated Payment System and
Method**

Confirmation No.: 9478

Art Unit: 3626

Examiner: Alexander Kalinowski

Atty. Docket: 2041.0010004

Third Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Applicant has listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicant reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent

application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicant has checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed concurrently with the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.
- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
 - ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign

application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☒ 7. Copies of documents AG2, AH3, AI3, AA4-AD4, AO6-AR6, and AN7-AR7 are submitted herewith.
- ☒ 8. Copies of documents AA1-AI1, AA2-AF2, AH2, AI2, AA3-AG3, AN1-AR1, AN2-AR2, AN3-AR3, AN4-AR4, AN5-AR5, and AN6 were cited by or submitted to the Patent Office in Information Disclosure Statements that comply with 37 C.F.R. § 1.98(a)-(c) in Application No. 08/879,022, filed June 19, 1997; and/or Application No. 08/625,295, filed April 1996; and/or Application No. 07/959,930, filed October 15, 1992, which are relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

- ☐ 9. No copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003.
- ☒ 10. It is expected that the examiner will review the prosecution and cited art in Parent Application Nos. 08/879,022, filed June 19, 1997; 08/625,295, filed April 1996; and 07/959,930, filed October 15, 1992 in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution histories has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

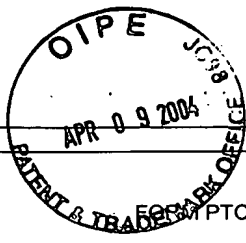


Evan R. Smith
Attorney for Applicant
Registration No. 35,683

Date: 4/9/04

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT FORM PTO-1449	ATTY. DOCKET NO. 2041.0010004	APPLICATION NO. 09/492,133
	INVENTOR Robert E. POLLIN	
	FILING DATE January 27, 2000	ART UNIT 3626

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	RE32,985	07/1989	Nagata <i>et al.</i>			
	AB1	4,321,672	03/1982	Braun <i>et al.</i>			
	AC1	4,381,705	05/1983	Roes <i>et al.</i>			
	AD1	4,385,285	05/1983	Horst <i>et al.</i>			
	AE1	4,494,127	01/1985	King			
	AF1	4,623,965	11/1986	Wing			
	AG1	4,630,201	12/1986	White			
	AH1	4,758,714	07/1988	Carlson <i>et al.</i>			
	AI1	4,810,866	03/1989	Lord, Jr.			

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FOREIGN PATENT DOCUMENTS

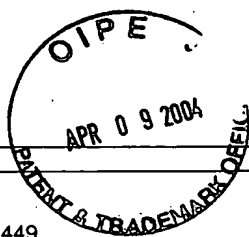
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AJ						Yes No
	AK						Yes No
	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AN	1	Defendant's Expert Report, Michael J. Franklin, Nov. 11, 1997.
AO	1	Memorandum Opinion, Frederic N. Smalkin, United States District Judge, Mar. 5, 1998.
AP	1	Dans, Ronald, "Direct Debiting--An Alternative To Credit Card Processing," Telemarketing Magazine, pp. 46-47, Aug. 1991.
AQ	1	Dans, Ronald, "New Credit Card Processing Nightmare For Telemarketers . . . And One Partial Solution," Teleprofessional Magazine, pp. 18-19, Sep. 1991.
AR	1	Maturi, Richard J., "Running A Better Business," Entrepreneur Magazine, pp. 214, 216-217, Jul. 1992.

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



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U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	4,823,264	04/1989	Deming			
	AB2	4,948,174	08/1990	Thomson <i>et al.</i>			
	AC2	4,960,981	10/1990	Benton <i>et al.</i>			
	AD2	4,974,878	12/1990	Josephson			
	AE2	5,051,900	09/1991	Ito <i>et al.</i>			
	AF2	5,053,607	10/1991	Carlson			
	AG2	5,085,470	02/1992	Peach <i>et al.</i>			
	AH2	5,111,395	05/1992	Smith <i>et al.</i>			
	AI2	5,117,355	05/1992	McCarthy			

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	AJ						Yes No
	AK						Yes No
	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AN	<u>2</u>	Letter of Jul. 27, 1993 from Jones, Tullar & Cooper, PC Regarding pending patent application of Robert Pollin.
AO	<u>2</u>	Westcorp Software Systems, Inc., MICRO PRO Series Brochure.
AP	<u>2</u>	Acuprint letter of reseller Direct Check, Inc. Brochure.
AQ	<u>2</u>	The Nilson report, Month of Jun., 1993, Issue 550 Collection Software Brochure.
AR	<u>2</u>	Auto-Pay Schedule of fees for collection agencies.

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	AA3	5,121,945	06/1992	Thomson <i>et al.</i>			
	AB3	5,126,936	06/1992	Champion <i>et al.</i>			
	AC3	5,231,571	07/1993	D'Agostino			
	AD3	5,233,547	08/1993	Kapp <i>et al.</i>			
	AE3	5,237,159	08/1993	Stephens <i>et al.</i>			
	AF3	5,265,007	11/1993	Barnhard, Jr. <i>et al.</i>			
	AG3	5,326,959	07/1994	Perazza			
	AH3	5,491,325	02/1996	Huang <i>et al.</i>			
	AI3	5,963,647	10/1999	Downing <i>et al.</i>			

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	AK						Yes No
	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AN	<u>3</u>	Sample Check.
	AO	<u>3</u>	Copy of an Agreement.
	AP	<u>3</u>	Copy of an Auto Pay Brochure.
	AQ	<u>3</u>	Brochure: Freedom From Telecom Support Systems.
	AR	<u>3</u>	Brochure: International Banking Technology.

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	AA4	5,966,698	10/1999	Pollin			
	AB4	6,006,208	12/1999	Forst <i>et al.</i>			
	AC4	6,227,447 B1	05/2001	Campisano			
	AD4	6,341,724 B2	01/2002	Campisano			
	AE4						
	AF4						
	AG4						
	AH4						
	AI4						

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	AJ						Yes No
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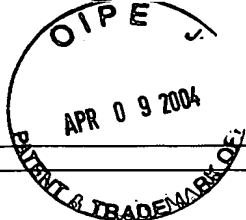
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AN	<u>4</u>	"Germantown Firm Charges Ahead With Automatic Payment Program," Germantown Gazette.
	AO	<u>4</u>	Check by phone materials.
	AP	<u>4</u>	Fidelity Check Incorporated, Letter to prospective client.
	AQ	<u>4</u>	Dans, Ron, QuickCard Systems, promotional Letter, 3 pages, dated Sep. 1, 1990.
	AR	<u>4</u>	Protest filed by Mr. Shawn J. Noel on or about Jul. 20, 1994.

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	AJ						Yes No
	AK						Yes No
	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AN	<u>5</u>	Protest filed by Shawn J. Noel on or about Sep. 16, 1994.
AO	<u>5</u>	Protest filed by Mr. Donald Pette, Jr., of Direct Check, Inc. on or about Sep. 21, 1994.
AP	<u>5</u>	Protest filed by Attorney William A. Blake on or about Oct. 26, 1994, assumed to be on behalf of Mr. Ronald Dans [hereinafter Dans protest].
AQ	<u>5</u>	Acuprint Brochure, letter to reseller, date unknown.
AR	<u>5</u>	Unknown Author, "Meanwhile Back Home," Interactive World, p. 20, Sep. 1992.

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	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AN	<u>6</u>	Microsoft Press Computer Dictionary, Second Edition, p. 191, (1994).
AO	<u>6</u>	Notice of Deposition of Intuit, Inc., Filed in Intell-A-Check Corporation v. Autoscribe Corporation et al., United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM), 9 pages, dated April 18, 2003.
AP	<u>6</u>	Amended Notice of Deposition of Paychex, Inc., Filed in Intell-A-Check Corporation v. Autoscribe Corporation et al., United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM), 10 pages, dated April 21, 2003.
AQ	<u>6</u>	Intell-A-Check's Supplemental Responses to Autoscribe's Requests for the Production of Documents and Things, Filed in Intell-A-Check Corporation v. Autoscribe Corporation et al., United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM), 15 pages, dated April 30, 2003.
AR	<u>6</u>	Memorandum of Law in Support of Intell-A-Check Corp.'s Construction of the Meaning and Scope of the Elements of the Claims of the Patents-In-Suit, Filed in Intell-A-Check Corporation v. Autoscribe Corporation et al., United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM), 49 pages, dated May 22, 2003.

EXAMINER

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	AJ						Yes No
	AK						Yes No
	AL						Yes No
	AM						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AN	<u>I</u>	Brief in Support of Defendants' Proposed Claim Construction, Filed in Intell-A-Check Corporation v. Autoscribe Corporation <i>et al.</i> , United States District Court for the District of New Jersey, Civil Action No. 01-4625 (Judge Martini), 49 pages, dated May 22, 2003.
	AO	<u>I</u>	Reply Memorandum of Law Regarding Claim Construction, Filed in Intell-A-Check Corporation v. Autoscribe Corporation <i>et al.</i> , United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM) (RJH), 21 pages, dated August 14, 2003.
	AP	<u>I</u>	Intell-A-Check's Second Supplemental Responses to Autoscribe's First Set of Interrogatories, Filed in Intell-A-Check Corporation v. Autoscribe Corporation <i>et al.</i> , United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WHW), 25 pages, dated September 13, 2003.
	AQ	<u>I</u>	Intell-A-Check's Supplemental Memorandum of Law in Support of Its Construction of the Claims of the Patents-In-Suit, Filed in Intell-A-Check Corporation v. Autoscribe Corporation <i>et al.</i> , United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM), 10 pages, dated November 21, 2003.
	AR	<u>I</u>	Defendants' Supplemental Memorandum in Reply to Intell-A-Check's Supplemental Memorandum of Law on Claim Construction, Filed in Intell-A-Check Corporation v. Autoscribe Corporation <i>et al.</i> , United States District Court for the District of New Jersey, Civil Action No. 01-4625 (WJM) (RJH), 19 pages, dated December 19, 2003.

EXAMINER

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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.